

## REMARKS

This is intended as a full and complete response to the Office Action dated October 11, 2006, having a shortened statutory period for response set to expire on January 11, 2007. Please reconsider the claims pending in the application for reasons discussed below.

### *Drawings*

The drawings stand objected to under 37 C.F.R. § 1.83(a). In response, Applicants cancelled claim 89, without prejudice, which recited that "the sealing member is mounted internally of the expandable tubular." Accordingly, Applicants respectfully request withdrawal of the rejection.

### *Claim Rejections - 35 U.S.C. § 112*

Claim 97 stands rejected under 35 U.S.C. § 112, second paragraph. In response, Applicants cancelled claim 97, without prejudice. Accordingly, Applicants respectfully request withdrawal of the rejection.

Also, the Examiner states that the fax copy of claim 124 in the preliminary amendment is unclear. The preliminary amendment on file contained claims 124-158 that appear to have been scanned into a separate file from the other claims during processing into the image file wrapper based on the status in PAIR. Applicants request first prosecution of claims 124-158, which are presented herein, due to this omission of these claims.

### *Double Patenting*

Claims 1, 3, 4, 7, 8, 10, 11, 14, 47, 48, 98, 101-104, 107, 109 and 114 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 22-31 of U.S. Patent 6,988,557. Claims 12-15, 105, 106, and 112-123 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 22-31 of U.S. Patent No. 6,988,557 in view of *Wood et al.* (U.S. Patent No. 6,073,692). In response, Applicants

submit that the terminal disclaimer filed herewith overcomes the rejection. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

### ***Claim Rejections - 35 U.S.C. § 102***

Claims 1, 4, 7, 8, 10-15 and 112-124 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Wood et al.* (U.S. Patent No. 6,073,692). In response, Applicants respectfully traverse the rejection.

Claim 1 recites the limitation of “an expandable tubular support member having a flow port” that “provides a flow path between an interior of the support member and a chamber defined by the seal element.” By contrast, a mandrel (reference number 14) of a packer disclosed in *Wood et al.* has a solid wall since the technique taught therein has the purpose to eliminate openings in the mandrel wall. See, Col. 2, lines 14-19. Therefore, *Wood et al.* fails to teach, show or suggest each and every element of claim 1 or claims 4, 7, 8, 10-15 and 158 dependent thereon. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of these claims.

Claim 112 recites a method that includes running a sealing apparatus having a “fluid retaining material disposed in the annular area, wherein the material is a swelling elastomer.” There is no indication that an inflation medium (22) disclosed in *Wood et al.* is a swelling elastomer. Thus, *Wood et al.* fails to teach, show or suggest each and every element of claim 112 or claims 113-117 dependent thereon. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of these claims.

Claim 118 recites a method that includes “running a packer into the wellbore, the packer having a sealing element and a filler material, wherein the filler material is disposed in the packer prior to the running” and then “introducing a fluid into the packer.” In *Wood et al.*, all materials for the inflation medium (22) that mix are disposed in pockets (20) upon assembly of the packer prior to being run into position in a wellbore. See, Col. 6, lines 14-29. Therefore, *Wood et al.* fails to teach, show or suggest each and every element of claim 118 or any claims dependent on claim 118. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of claims 118-123.

Claim 124 includes the limitation of “a material disposed in the annular area, the material adapted to retain at least a portion of a fluid supplied to the annular area, wherein the fluid comprises water.” The inflation medium (22) disclosed in *Wood et al.* has materials that lack any indication of having water and are all disposed in pockets (20) upon assembly of the packer prior to being run into position in the wellbore. Therefore, *Wood et al.* fails to teach, show or suggest each and every element of claim 124. Accordingly, Applicants submit that claim 124 and all claims dependent thereon are allowable and respectfully request withdrawal of the rejection and allowance of claims 124-127 and 129-157.

Claims 80-85, 89, and 91-96 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Vick, Jr.* (U.S. Patent No. 6,059,038). In response, Applicants respectfully traverse the rejection.

Claim 80 includes the limitations of “an expandable tubular support member having a flow port” and “an inflatable seal element mounted externally of the expandable tubular support member for inflation radially outwardly into sealing engagement with at least a portion of the wellbore, wherein the flow port provides a flow path between an interior of the support member and a chamber defined by the seal element.” *Vick, Jr.* fails to teach, show or suggest an apparatus with an inflatable seal element, as claimed, and cannot anticipate claim 80 or claims dependent thereon. Accordingly, Applicants request withdrawal of the rejection and allowance of claims 80-85, 89, and 91-96.

Claims 80-87 and 91-94 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Little* (U.S. Patent No. 1,854,518). In response, Applicants respectfully traverse the rejection.

Claim 80 includes the limitations of “an expandable tubular support member having a flow port” and “an inflatable seal element mounted externally of the expandable tubular support member for inflation radially outwardly into sealing engagement with at least a portion of the wellbore, wherein the flow port provides a flow path between an interior of the support member and a chamber defined by the seal element.” *Little* fails to teach, show or suggest an apparatus with an inflatable seal element, as claimed, and cannot anticipate claim 80 or claims dependent thereon.

Accordingly, Applicants request withdrawal of the rejection and allowance of claims 80-87 and 91-94.

### ***Claim Rejections - 35 U.S.C. § 103***

Claim 97 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wood et al.* in view of *Vick, Jr.*, or *Little*. The Examiner states that it would have been obvious to provide expandable tubing (14) of *Wood et al.* with sealing members of *Vick, Jr.*, or *Little* to ensure that fluid is delivered to the chambers (20) only once a predetermined fluid pressure has been reached. In response, claim 97 has been cancelled. Further, Applicants respectfully traverse the rejection as it may be applied to claim 80, which has been amended to include subject matter of previous claim 97.

Claim 80 recites the limitation of “an expandable tubular support member having a flow port” that “provides a flow path between an interior of the support member and a chamber defined by the seal element.” As discussed above regarding claim 1, the mandrel (14) disclosed in *Wood et al.* has a solid wall since the technique taught therein has the purpose to eliminate openings in the mandrel wall. See, Col. 2, lines 14-19. Fluid is never delivered to pockets (20) of the packer in *Wood et al.* through ports of an expandable tubular support member, as claimed. Therefore, no combination of *Wood et al.* and *Vick, Jr.*, or *Little* teaches, shows or suggests a sealing apparatus as recited in claim 80. Applicants request withdrawal of the rejection and allowance of claim 80 and all claims dependent thereon.

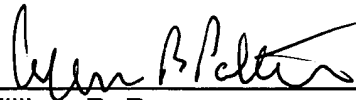
### ***Allowable Subject Matter***

Claims 49-52, 54-56, 99, 100, and 108 are objected to as being dependent upon a rejected base claim. In response, Applicants submit that these claims are patentable based at least on the traversal presented herein regarding the independent claims from which 49-52, 54-56, 99, 100 and 108 depend. Accordingly, Applicants respectfully request withdrawal of the objection and allowance of the claims.

***Conclusion***

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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